

DOCKET NO.: 220944US8/pae



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:  
Hisashi NAKAGOMI, et al.

GROUP: 2135

SERIAL NO: 10/098,575

EXAMINER: PAN, J. T.

FILED: March 18, 2002

FOR: MOBILE COMMUNICATION TERMINAL DEVICE AND SERVER DEVICE

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
HISASHI NAKAGOMI, ET AL. : EXAMINER: PAN, J.  
SERIAL NO: 10/098,575 :  
FILED: MARCH 18, 2002 : GROUP ART UNIT: 2135  
FOR: MOBILE COMMUNICATION :  
TERMINAL DEVICE AND SERVER  
DEVICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Office Action dated March 3, 2008, please consider the following  
PRE-APPEAL BRIEF REQUEST FOR REVIEW.

**Remarks/Arguments** begin on page 2 of this paper.

In the O.G. Notice dated July 12, 2005, the PTO established a New Pre-Appeal Brief Conference Pilot Program. In an O.G. Notice dated February 7, 2006, the PTO extended the program until further notice. The goals of the program, as set forth on page 1 of the July 12, 2005 O.G. Notice, “are (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the omission or presence of essential elements required to establish a prima facie rejection.” For the reasons which follow, Applicant believes that both goals are met by Applicant’s remarks, and that a finding should be issued that “[t]he application is allowed on the existing claims and the prosecution remains closed.”<sup>1</sup>

Claims 1-22 are pending in the present application. By way of summary, the Official Action (Final Rejection mailed December 11, 2007) presents the following issues; Claims 1-4, 6-11, 14-20 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ono in view of Yoshizawa. Claims 5, 12, 13 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ono in view of Yoshizawa and further in view of Tanaka.

Turning first to the rejection of Claims 1-4, 6-11, 14-20 and 22 under 35 U.S.C. §103(a) as being unpatentable over Ono in view of Yoshizawa, the Official Action takes the position, with respect to Claim 1, that Ono discloses a detection unit configured to detect which of the plurality of communication link security levels is in use at a remote device. The Official Action (page 3) relies on Figure 7, step S206, column 12, lines 28-55, and column 3, lines 17-21. The Official Action relies on Figure 1, element 221, the input/output control unit, and column 3, lines 17-21 of Ono for a teaching of an announcing unit configured to announce said detected communication link security level, wherein each of said plurality of said communication security link levels corresponds to a strength of ciphering in use at the remote device. In addition, the Official Action takes the position (page 3) that Ono discloses detecting which of the plurality of communication link security levels, i.e., encryption, digital signature, encryption and digital signal, etc., (see Figure 7 of Ono) is in use at the remote device. However, the Official Action asserts that Ono does not explicitly mention the term “security level.” To overcome this deficiency of Ono, the Official Action turns to Yoshizawa for teaching of a radio communication device and user authentication method which discloses selecting a security level from a plurality of security levels in accordance with the condition of the radio communication, relying on column 2, lines 62-64 of Yoshikawa.

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<sup>1</sup> July 12, 2005 notice, page 4.

Claim 1 recites “a detection unit configured to detect which of the plurality of communication link security levels is in use at the remote device as said preset communication link security level.”

For the reasons which follow, Applicants assert that even if, *arguendo*, the teachings of Ono and Yoshikawa were combined as advanced in the Official Action, the combined teachings of the references fall short of meeting all of the limitations of the independent claims. With regard to claim 1, Applicants do not find the above-quoted limitation.

Ono recites (col. 3, ll. 17-21) that “[a]ccordingly, the message receiving apparatus can specify whether to encrypt/digitally sign the message and which encryption/digital signature method should be used.” Ono goes on to additionally state that the encryption/digital signature method specified by the message receiving apparatus is based on the user attribute of the of the message transmitting apparatus (col. 3, lines 17-20). Because the operation of the message receiving apparatus is based on the user attribute of the message transmitting apparatus (col. 3, lines 19-20) it is not a reflection of the security level in effect at the remote device, and is not a preset communication link security level of the remote device. Accordingly, Ono does not disclose the detecting limitation recited in Claim 1.

It therefore follows that Ono also does not disclose the claimed announcing unit configured to announce the detected communication link security level, where each of the said plurality of communication security link levels corresponds to a strength of ciphering in use at the remote device, because Ono does not disclose detection of which of the plurality of security levels is in use at the remote device as said preset communication link security level, as recited in Claim 1. In addition, since Ono is directed to (col. 1, lines 53-60) encryption/digital signature of messages, Ono is not related to the claimed communication via a plurality of communication link security levels, as is the claimed invention.

Turning to Yoshizawa, the Official Action takes the position that Yoshizawa teaches a radio communication device and user authentication method wherein Yoshizawa discloses “selecting a security level from a plurality of security levels in accordance with the condition of the radio communication,” (underlining added), relying on column 2, lines 62-64 of Yoshizawa. In Yoshizawa the condition of the radio communication referred to is positional information (col. 8, line 29). However, selecting a security level from a plurality of security levels in accordance with positional information, is not a detection of which security level is in use at the remote device as said preset communication link security level, as recited in claim 1. Nor does transmitting a password from device A to device B with device B then

verifying the password (col. 5, line 48 through col. 6, line 5), a teaching or suggestion of the claim language.

Thus, Yoshizawa does not make up for the deficiencies outlined above with respect to Ono. In addition, because Ono is directed to a message receiving apparatus for receiving messages converted for secret communication and Yoshizawa is directed to a radio communication device with password management, Applicants find no reason to combine the teachings of the two references other than an impermissible hindsight reconstruction of Applicants' invention. Accordingly, Applicants' believe that the rejection of claims 1-4, 6-11, 14-20 and 22 under 35 U.S.C. § 103(a) is in error and should be withdrawn.

Turning next to the rejection of Claims 5, 12, 13 and 21 under 35 U.S.C. §103(a) as being unpatentable over Ono in view of Yoshizawa and Tanaka, Applicants maintain that these claims are patentable for the reasons set forth, *supra*, with respect to Ono and Yoshizawa and because Tanaka does not cure the deficiencies of Ono and Yoshizawa. Tanaka describes a camera control device and method for storing programs in a communication medium where, if a video display area in use is selected, the user is urged to select either to continue or to stop. Although Tanaka allows a user to continue or stop an operation, Tanaka is wholly unrelated to the issues involving Applicant's invention or the inventions of Ono or Yoshizawa. Thus, Tanaka does not disclose or suggest any processing based on a communication security level in a remote device, as recited in Applicants' claims 5, 12, 13, and 21.

Moreover, as stated in the Amendment filed September 17, 2007, "[i]ndeed, as acknowledged by the Examiner's supervisor during the interview of July 26, 2007, the camera control device of Tanaka is not analogous to Applicants' claimed invention." M.P.E.P. §2141.01(a)(i) sets forth that to rely on a reference under 35 U.S.C. §103 the reference must be analogous art. In this instance, **because Tanaka was acknowledged by the Examiner's SPE to be nonanalogous art, it is inappropriate to rely on the reference in a rejection under 35 U.S.C. §103.** Accordingly, Applicants' believe that for this additional reason, a *prima facie* case of obviousness has not been established for claims 5, 12, 13 and 21.

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Reply to Office Action of December 11, 2007.

From all of the above, Applicants request that the rejection of Claims 5, 12, 13 and 21 under 35 U.S.C. § 103(a) also be withdrawn, and that the application be allowed.

Respectfully submitted,

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